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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/594,435

12/29/2007

Shunichi Haga

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MILES & STOCKBRIDGE PC
1751 PINNACLE DRIVE
SUITE 500
MCLEAN, VA 22102-3833

EXAMINER

AMARI, ALESSANDRO V

ART UNIT

PAPER NUMBER

2872

NOTIFICATION DATE

DELIVERY MODE

08/20/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ipdocketing@milesstockbridge.com
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| | | | |
|------------------------------|--------------------------------------|------------------------------------|--|
| Office Action Summary | Application No. 10/594,435 | Applicant(s) HAGA ET AL. | |
| | Examiner ALESSANDRO AMARI | Art Unit 2872 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 10, 12, 14, 15, 17, 20, 21 and 23 is/are pending in the application.
- 4a) Of the above claim(s) 10, 12, 14, 15, 17, 20, 21 and 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 September 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>9/26/06; 12/29/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election of Group I (claims 3-6) in the reply filed on 14 June 2010 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Claims 10, 12, 14, 15, 17, 20, 21 and 23 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Invention, there being no allowable generic or linking claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Nakajima
US 2004/0125443.

In regard to claim 1, Nakajima discloses (see Figures 2, 8, 9, 10, 15) an observation device having an ocular lens (3Lc) and an objective lens (3La) and adapted

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to observe through said ocular lens an intermediate image (Mb) of an object formed by said objective lens, said observation device comprising: a display section (32) that is provided either on a light path connecting said ocular lens and said objective lens or on a light path branched off from the light path and displays an image as described in para. [0063]; and a light path switching section as shown in Figure 10 that is provided on the light path connecting said ocular lens and said objective lens and switches light to be guided from said ocular lens to said objective lens and the image displayed on said display section to be guided to said ocular lens or said objective lens as described in para. [0065] – [0070].

In regard to claim 2, Nakajima discloses (see Figures 2, 15) an observation device having an ocular lens (3Lc) and an objective lens (3La) and adapted to observe through said ocular lens an intermediate image (Mb) of an object formed by said objective lens, said observation device comprising: a display section (32) that is provided either on a light path connecting said ocular lens and said objective lens or on a light path branched off from said light path and displays an image; and a light path dividing section (52) that is provided on the light path connecting said ocular lens and said objective lens, and guides light from said ocular lens to said objective lens and guides the image displayed on said display section to said ocular lens or said objective lens as described in para. [0102].

Regarding claims 3 and 4, Nakajima discloses that said light path switching/dividing section is provided on the light path connecting said ocular lens and said objective lens at a position between said objective lens and a position where the

intermediate image of the object is formed, and switches a light flux guided between said objective lens to said ocular lens and a light flux guided between said display section and said objective lens as shown in Figures 2, 9, 10 and 15.

Regarding claims 5 and 6, Nakajima discloses that said light path switching/dividing section is provided on the light path connecting said ocular lens and said objective lens at a position between said ocular lens and a position where the intermediate image of said object is formed, and switches a light flux guided between said objective lens and said ocular lens and a light flux guided between said display section and said ocular lens as shown in Figures 2, 9, 10 and 15.

Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Khoshnevis et al (hereafter "Khoshnevis") US 2002/0034004.

In regard to claim 1, Khoshnevis discloses (see Figure 2A) an observation device having an ocular lens (19a, b) and an objective lens (16a, b) and adapted to observe through said ocular lens an intermediate image of an object formed by said objective lens, said observation device comprising: a display section (48) that is provided either on a light path connecting said ocular lens and said objective lens or on a light path branched off from the light path and displays an image; and a light path switching section (38a, 38b, 34a, 34b) that is provided on the light path connecting said ocular lens and said objective lens and switches light to be guided from said ocular lens to said objective lens and the image displayed on said display section to be guided to said ocular lens or said objective lens as described in para. [0026] – [0032].

In regard to claim 2, Khoshnevis discloses (see Figure 2A) an observation device having an ocular lens (19 a, b) and an objective lens (16a, b) and adapted to observe through said ocular lens an intermediate image of an object formed by said objective lens, said observation device comprising: a display section (48) that is provided either on a light path connecting said ocular lens and said objective lens or on a light path branched off from said light path and displays an image; and a light path dividing section (34a, 34b) that is provided on the light path connecting said ocular lens and said objective lens, and guides light from said ocular lens to said objective lens and guides the image displayed on said display section to said ocular lens or said objective lens as described in para. [0026] – [0032].

Regarding claims 3 and 4, discloses that said light path switching/dividing section is provided on the light path connecting said ocular lens and said objective lens at a position between said objective lens and a position where the intermediate image of the object is formed, and switches a light flux guided between said objective lens to said ocular lens and a light flux guided between said display section and said objective lens as shown in Figure 2A.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALESSANDRO AMARI whose telephone number is (571)272-2306. The examiner can normally be reached on Monday-Friday 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephone B. Allen can be reached on (571) 272-2434. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

12 August 2010

/Alessandro Amari/
Primary Examiner, Art Unit 2872